

REMARKS

Applicant has amended the Background of the Invention to describe the importance of eye alignment in putting and prior art methods for achieving such alignment. Applicant submits that the amendments merely incorporate into the Background of the Invention subject matter that was well known in the prior art and that does not in any way alter the scope or features of the invention. The added matter is disclosed in materials previously submitted during the prosecution of the present application (e.g. the Declaration of the Inventor, Gary Lister).

Claim 8 has been amended in an effort to more precisely define the invention. No new matter has been added. Applicant submits that the amendments are fully supported by the application as originally filed.

The Examiner has again rejected the present application, saying that the invention is obvious in light of Pelz, Condon and Jackson. In the Office Action of August 23, 2005, the Examiner states: "it would have been obvious in view of Condon and Jackson to one having ordinary skill in the art to modify the golf putter of Pelz with centerline marker as taught by Condon and intersection of the axis of the shaft and vertical line drawn perpendicular to the sweet spot as taught by Jackson in order to provide a putter with proper alignment of the transverse marking with the centerline marker."

It may or may not be obvious to combine Pelz, Condon and Jackson to provide "a putter with proper alignment of the transverse marking with the centerline marker." However, Applicant does not simply claim a putter having a transverse marking and a centerline marker that can be aligned. Applicant claims a putter having a transverse marking and a centerline marker in specific relative positions that allow the golfer to precisely align his or her eyes over the ball. This specific relative positioning of the centerline marker and transverse marking is not disclosed, suggested or obvious in light of Pelz, Jackson and Condon. In fact, Pelz, Jackson and Condon teach away from such alignment.

Regarding this relative positioning of the centerline marker and transverse marking, the Examiner says : "[w]ith respect to the user's line of sight from a straight line perpendicular the putting surface that connects the user's eyes, the transverse marker and the centerline marker of said putter head ensuring the user's eyes are vertically over the centerline of said putter head, Pelz discloses the index mark 42' on the shaft is aligned with the index mark 28 or centerline marker of the putter head and the alignment is done "visually" by the golfer (col.4, lines 1-4)."

It appears that the Examiner is saying that Pelz discloses two index marks (42' and 28) that are aligned visually. However, simply visually aligning two index marks can result in the golfer adopting any one of an infinite number of *incorrect* body positions. Applicant is

not simply trying to claim a golf club having index marks that can be aligned visually.

The Examiner has not indicated how or where Pelz, or any of the other prior art references cited, disclose or suggest the placement of such marks on a straight line perpendicular the putting surface.

The Examiner has not indicated how or where Pelz, or any of the other prior art references cited, disclose or suggest positioning the golfer's eyes over the ball.

That is precisely the point of Applicant's invention; to enable golfers to align their eyes over the ball when putting.

Applicant admits that Pelz, Condon and Jackson together disclose a club having a marker on the club head, and a marker on the shaft, that may be aligned to achieve a given body position. However, Applicant is not claiming such a golf club. In the present invention, the mark on the club head and the mark on the shaft have precise relative positions that result in a very specific positioning of the golfer's body. Specifically, the mark on the club head (the centerline marker) and the mark on the shaft (the transverse marking) are positioned such that the latter is directly above the former. Both marks lie on a straight line perpendicular to the putting surface. As a result, the golfer's eyes are positioned directly above the marks when they are visually aligned.

Applicant has attached hereto, as Exhibit A, drawings showing side-by-side the golf clubs of Pelz, Jackson, Condon and Applicant (Lister).

As can be seen from the drawings, the club of Pelz has a mark on the heel of the club head (i.e. it does not mark a desired area of putter-to-ball impact). Pelz also has a plurality of markings on the shaft. When the mark on the heel of the club head and the markings on the shaft are visually aligned by the golfer, the golfer's eyes could be in any of a number of positions. The golfer's line of sight forms an indeterminate angle with the putting surface that is less than 90 degrees. Even if the angle formed by the golfer's line of sight and the putting surface was 90 degrees, the golfer's eyes would not be over the ball because the mark on the heel of the club head does not indicate the desired area of putter-to-ball impact. In fact, the mark on the heel of the club is not intended to be aligned with the ball in any way; it is simply used for visual alignment with the markings on the shaft.

As can be seen from the drawing of Jackson, Jackson does not even disclose a mark on the club head. This is because Jackson is not concerned with eye alignment. Jackson specifically requires that the handle be positioned above the target line, thereby blocking the golfer's view of the ball. It is not clear how one could combine the teachings of Pelz and Jackson since the former requires visual alignment of markings on the shaft and club head and the latter places the handle above the target line, effectively blocking the view of the club head. It appears

that the only configuration that would successfully combine the teachings of both patents would result in the golfer leaning past the target line so that his or her eyes are over the toe of the club. This would allow the golfer simultaneously to maintain his or her hands above the target line and to visually align marks on the shaft and club head. In terms of putting technique, such alignment is simply incorrect. Such alignment would also be likely to cause strain on golfers' backs.

Condon discloses a club having markings on the club head which indicate the desired area of putter-to-ball impact. However, the markings of Condon are not aligned with anything but the ball. Visual alignment of the markings has little or no effect on the golfer's body or eye position, and the golfer's line of sight forms an indeterminate angle with the putting surface. The markings of Condon simply help to align the club head with the ball. Furthermore, combining Condon with Jackson and Pelz will not alleviate the problem discussed above. The golfer's hands will still be on the target line (as required by Jackson) and the golfer will still have to lean past the target line so that their eyes are over the toe of the club head (in order to visually align markings on the shaft and club head, as taught by Pelz).

Unlike Pelz, Jackson and Condon, the present application (Lister) teaches a golf club that enables golfers to achieve specific and well-defined positioning, with the eyes directly over the ball. A marking on the club head, indicating the desired area of putter-to-ball

impact is visually aligned with a marking on the shaft, thereby placing the golfer's eyes over the ball. With Applicant's club, the golfer's line of sight forms a 90-degree angle with the putting surface, and the ball and target line are at the apex of that 90-degree angle. "Eyes over the ball" is the only alignment contemplated by the present application. Pelz contradicts the present application because Pelz teaches a number of markings, resulting in a number of possible body positions, none of which are related to the location of the ball. Applicant's club is totally incompatible with the teaching of Jackson because Jackson places the golfer's hands over the ball, rather than the eyes. Condon is merely irrelevant to the present application since it does not discuss alignment of the golfer's eyes at all.

The drawings in Exhibit A, along with the above discussion show that the references cited by the Examiner do not disclose all of the features of the claimed invention. Applicant submits that in order to support the conclusion that the claimed invention is obvious, the Examiner has used impermissible hindsight to ignore some elements of the prior art references (e.g. the fact that the handle of the club of Jackson must be positioned over the target line) while focusing on others (e.g. on page 4 of the Office Action: "Jackson is cited to show the inherent feature (user's line of sight or "visually" as disclosed by Pelz) the perpendicular line form between the user's line of sight that connect the shaft in relation to the sweet spot 15 or centerline marker.")

Applicant submits that the prior art cited by the Examiner does not disclose a golf club having markings in the specific positions required by claim 8 of the present application. In addition, the prior art cited by the Examiner does not disclose a golf club that enables a golfer to align his eyes directly over the ball. In fact, the prior art cited by the Examiner teaches away from the marker positioning and eye alignment of the present invention for the following reasons:

- 1) Pelz is equally applicable to woods, irons and putters (woods and irons do not require eyes over the ball);
- 2) Pelz uses a plurality of markings on the shaft so that golfers of different statures can use the club, (col. 3 lines 43-66; col. 4 lines 51-57; claim 1) whereas only one set of markings is required to align eyes over the ball, regardless of the golfer's stature;
- 3) Claim 1 of Pelz says that the "aligning means" allow the golfer to *select* a desired inclination and repeat same (there is only one correct position according the present invention);
- 4) Pelz only discusses alignment of body to club, (col. 5 lines 9-34; col. 3 lines 52-55; col. 2, lines 1-6) there is no discussion of alignment of the eyes relative to club or ball;
- 5) Pelz only discloses marks 28 and 82 on the club head, (col. 3, line 60 - col. 4, line 4; col. 4, lines 46-68; and Figs. 6 and 9) which are on the heel of the club head, (i.e. closer to the golfer than the ball and target line) and therefore would result in improper alignment of the golfer's eyes (i.e. not over the ball but rather inside the target line); and

6) Jackson teaches that the golfer's hands should be aligned on the target line, effectively blocking the golfer's view of the club head and ball, and preventing the golfer from aligning his eyes over the ball.

With respect to point 4 above, the Examiner made the following comment in the Office Action of August 23, 2005: "Applicant further argued that neither Pelz nor Condon nor Jackson discloses nor suggests the transverse marking and the centerline marker are positioned so that the golfer's eyes are positioned over the ball as recited in claim 8. Examiner respectfully disagrees. Note, claim 8 recites the user's line of sight forms a perpendicular line that connect the user's eyes, the transverse marker and the centerline marker of the putter head not 'the golfer's eyes are positioned over the ball.'"

Applicant submits that whether Applicant claimed "the golfer's eyes are positioned over the ball" or "the golfer's eyes are positioned over the putter head," or "wherein said centerline marker and said transverse marking are positioned such that they both lie on a straight line perpendicular to a putting surface" (see claim 8 as presently amended) the claim would be distinguished from the prior art. For the purpose of distinguishing from the prior art, it makes no difference whether the present invention is characterized as aligning the user's eye over the ball or the centerline marker or over the target line; such alignment is not shown or suggested by the prior art.

Nevertheless, Applicant has amended the Background of the Invention to clarify what is meant by the expression "having your eyes over the ball." For greater clarity, claim 8 as presently amended recites a line perpendicular to a putting surface and eyes over the ball.

Despite the Examiner's blanket assertion that the present invention is obvious in light of Pelz, Applicant submits that no comparable product has appeared on the market in the 35 years since the issue of the Pelz reference.

Dave Pelz, one of the pre-eminent authorities on putting, is a prolific inventor, as shown by the following U.S. patents issued for his inventions in the years since the issue of the reference cited by the Examiner:
3,462,155; 4,130,282; 4,251,077; 4,437,669; 4,754,976;
4,688,798; 5,039,098; 5,431,403; 6,312,345; 6,503,152;
6,860,139.

Despite his expertise and ingenuity, Dave Pelz has not been able to address the long felt need for a putter having an eye alignment aid, thereby contradicting the Examiner's assertion that the present invention is obvious. The long felt need for a means to help golfers align their eyes over the ball when putting is shown by the Pelz articles previously submitted as Exhibits A-C of the Declaration of the Inventor, Gary Lister.

With respect to the Declaration of the Inventor previously submitted by Applicant, Applicant notes from

that last Office Action that the "Affidavits under 37 CFR 1.132 filed on 4/20/05 has been entered and considered." No further comment regarding the Declaration of the Inventor was made in the Office Action. Applicant further notes that MPEP § 716.01 states as follows:

"The following criteria are applicable to all evidence traversing rejections submitted by applicants, including affidavits or declarations submitted under 37 CFR 1.132:

(A) *Timeliness*. Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. *In re Rothermel*, 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

- prior to a final rejection,
- ...

(B) *Consideration of evidence*. Evidence traversing rejections, when timely presented, must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. The extent of the commentary depends on the action taken by the examiner. Where an examiner holds that the evidence is sufficient to overcome the *prima facie* case, the comments should be consistent with the guidelines for statements of reasons for allowance. See MPEP § 1302.14. Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are insufficient.

Accordingly, Applicant requests that the Examiner kindly provide an explanation as to why Applicant's evidence of a long felt need and the failure of others, is considered to be insufficient.

In summary, it appears that the Examiner concludes that the present invention is rendered obvious by a combination of prior art references teaching the following:

- 1) alignment of a golfer's hands on the target line when putting, (Jackson, see Summary of the Invention);
- 2) repetition of a desired alignment of the golfer's body relative to the ball when putting, driving or using an iron (Pelz, see Summary of the Invention);
- 3) elimination of vibrations and alignment of a centre of gravity of a putter with a ball (Lucetti, see Summary of the Invention); and
- 4) a multifunctional club head that can be used as a chipper and a putter (Condon, see Summary of the Invention).

Applicant submits that each one of these references is directed to a unique objective totally unrelated to alignment of the golfer's eyes over the ball. In fact, Applicant submits that positioning of the golfer's eyes is not mentioned even once in the references cited by the Examiner (visual alignment of markings is discussed in Pelz, however, positioning of the eyes is not). Furthermore, some of the references, such as Pelz and Jackson, actually contradict or teach away from the present invention. Accordingly, Applicant submits that the present application is not obvious in light of the references cited by the Examiner.

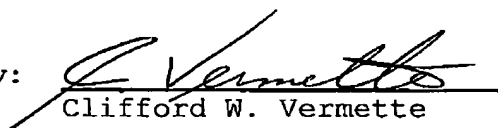
Applicant submits herewith for the Examiner's reference copies of Applicant's issued Canadian and UK patents for the same invention, marked as Exhibits "B" and "C", respectively.

Favourable consideration of this application is
respectfully solicited.

Respectfully submitted,

Dated: Nov. 8, 2005

By:


Clifford W. Vermette
Reg. No. 30,018
Attorney for Applicant

c/o Vermette & Co.
Box 40 Granville Square
230 - 200 Granville Street
Vancouver, British Columbia
Canada V6C 1S4
Tel: (604) 331 - 0381